

Remarks

The claim rejections are improper because the cited references do not disclose the limitations as asserted in the Office Action. Despite Applicant's traversals noting this lack of disclosure, the Final Office Action has improperly ignored the issue regarding the lack of correspondence as asserted, based upon misapplied case law. Moreover, the Office Action's reliance upon unsupported assertions that the claimed invention is simply "a matter of design choice," without citing to any reference that teaches or suggests the claim limitations, is contrary to relevant law and insufficient to establish and maintain a *prima facie* Section 103 rejection. For these and other reasons as discussed in greater detail below, Applicant believes that the rejections are improper and must be removed.

The instant Office Action dated July 28, 2008 listed the following rejections: claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103(a) over the Slavenburg reference (U.S. Patent No. 6,122,722) in view of the Martonosi reference (U.S. Patent No. 6,745,336); and claims 2 and 5-7 stand rejected under 35 U.S.C. § 103(a) over the Slavenburg and Martonosi references in further view of the Fisher reference (U.S. Patent No. 6,026,479). Applicant traverses all of the rejections and, unless stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

The Final Office Action appears to have repeated all claim rejections, word-for-word, adding only a few sentences in the Response to Arguments section while generally ignoring the majority of Applicant's traversals based upon an assertion that "one cannot show nonobviousness by attacking references individually where the rejections are based on the combination of references." Applicant submits that this approach to ignoring Applicant's traversals is untenable. Section 103 rejections rely upon individual teachings in different cited references, and motivation for combining those teachings. When a particular cited reference does not disclose limitations as asserted in an Office Action, traversals addressing the improper assertion of correspondence between a cited reference and the claimed invention are clearly appropriate. That is, while Applicant recognizes that a Section 103 rejection relies upon a combination of references, such a rejection is improper when an asserted reference does not teach or suggest the limitations as relied upon in the rejection. Moreover, Applicant's traversals regarding the Section 103 rejections address the combination of references because the combination does not teach or suggest the limitations as asserted (by nature of individual

references not teaching or suggesting the limitations). In this regard, Applicant maintains all traversals of record, and submits that the Examiner's misguided attempt to ignore Applicant's traversals is improper and further contrary to M.P.E.P. §707.07(f). The following highlights lack of correspondence between the cited references (in combination) and the claimed invention.

The Office Actions of record have failed to show correspondence to claim limitations directed to a multi-issue processor having a first set of issue slots with holdable registers on multiple data output paths of input routing networks, and a second set of issue slots with holdable registers on a single data input path of the input routing networks. The Office Actions of record have acknowledged that neither the '722 nor the '336 reference teaches corresponding first and second sets of issue slots as claimed. This is consistent with the cited references as the '722 reference does not teach any holdable registers (*see e.g.*, Figure 4), and the '336 reference fails to teach sets of issue slots that have different placements of holdable registers (*see e.g.*, Figure 4). The Final Office Action has not cited any reference that teaches or suggests placing the latches 30-36 in the '336 reference between the register file 403 and switching matrix 401 of the '722 reference.

Instead of showing correspondence to the limitations indicated as not present in the cited references, the Office Actions of record (including the Response to Arguments section of the instant Office Action) improperly rely upon allegations that the claimed invention is a mere "design choice," and stop far short of establishing a *prima facie* Section 103 rejection. For instance, the suggestion in the Response to Arguments section that "the placement of the latches/registers before or after the switching matrix, when the matrix is merely directing the inputs to the correct unit, is purely a matter of design choice" is unsupported by any cited reference or teaching. The further assertion of the Response to Arguments section that the claimed placement "would flow naturally from following the suggestion of the prior art," also fails to cite to any supporting teaching or suggestion. The Office Action's continued reliance upon these unsupported assertions, without citing any references disclosing the claim limitations, is contrary to the M.P.E.P. and applicable law, which requires that the rejection "provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device" (*see, e.g.*, M.P.E.P.

§ 2144.04(VI)(C) and *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984)).

As is further consistent with MPEP § 2144.04(VI)(C) regarding “design choice,” situations where such a design choice is applicable concern instances in which a rearrangement of parts would not have modified the operation of the device and where the purposes/goals for such design choices are aligned. In this instance and as is consistent with Applicant’s specification, the difference between the placement of the holdable registers in the first set of issue slots and the placement of the holdable registers in the second set of issue slots results in the first and second sets having different operational characteristics. *See e.g.*, Paragraphs 0018 and 0020. The first set of issue slots (*see, e.g.*, Figure 2) decreases power consumption but increases the amount of state that has to be saved during an interrupt. The second set of issue slots (*see, e.g.*, Figure 2) decreases the amount of state that has to be saved during an interrupt but has increased power consumption relative to the first set. The placement of the holdable registers is thus not “purely a matter of design choice” because the placement of the holdable register changes the operation of the issue slots. This discussion is consistent with Applicant’s traversals in the previous response of record, and has not been addressed in the instant Office action. Applicant therefore requests that the Section 103 rejections be removed because the Office Action has failed to establish teaching or suggestion of all claim limitations as required under Section 103, and has thus failed to establish a *prima facie* case of obviousness.

In view of the above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068 (or the undersigned).

Please direct all correspondence to:

Corporate Patent Counsel
NXP Intellectual Property & Standards
1109 McKay Drive; Mail Stop SJ41
San Jose, CA 95131

CUSTOMER NO. 65913

By: 

Name: Robert J. Crawford

Reg. No.: 32,122

651-686-6633 x2300

(NXPS.305PA)